

PROCEDURAL ISSUES

The M.P.E.P. requires that all actions on the merits issued by an Examiner “be complete.” 37 C.F.R. § 1.104(b). See also M.P.E.P. § 707.07. Specifically, 37 C.F.R. § 1.104(c)(2) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)(2); see also M.P.E.P. § 707.

The Examiner rejected claims 1-7, 9-45, and 47-59 under 35 U.S.C. § 102(e) as being obvious over *Ludwig*. Applicants, however, respectfully submit that the Office Action is incomplete because the Examiner did not accurately designate particular parts of *Ludwig* and did not explain the pertinence of *Ludwig* in rejecting the claims, as required by 37 C.F.R. § 1.104(c)(2). For example, the Examiner asserts that *Ludwig* discloses a “mark as corresponding to tag.” (*Office Action*, p. 3). Applicants, however, can find no disclosure of any “mark” in either the cited portions of *Ludwig* or the rest of the application, let alone any “mark as corresponding to tag.”

Further, in rejecting claims 33-34, 37-39, 49, 54, and 59, the Examiner stated only that “*Ludwig* and *Virgin* teach a method as claimed in claims 1, 11, 16, 23, and 28.” (*Office Action*, p. 5). However, Applicants respectfully submit that the Office Action is incomplete because the Examiner did not designate particular parts of *Ludwig* or *Virgin* in rejecting claims 33-34, 37-39, 49, 54, and 59, let alone specify a basis for combining these references.

Therefore, should the Examiner continue to dispute the patentability of pending claims 1-7, 9-45, and 47-59, Applicants request that the Examiner comply with MPEP requirements in any additional Office Actions.

REJECTION UNDER 35 U.S.C. § 102

Applicants respectfully traverse the Examiner's rejection of claims 1-7, 9-45, and 47-59 as anticipated by *Ludwig*. *Ludwig* does not teach each and every element recited in any of claims 1-7, 9-45, and 47-59, as required to support a proper rejection under 35 U.S.C. § 102(e). M.P.E.P. § 2131 (8th ed. 2001, 3rd rev, Oct. 2005).

Claim 1 recites a combination including a step of "receiving a request configured in a first format at the server system, wherein the request includes a tag that indicates a response format associated with the requesting entity." *Ludwig* does not teach this claim element. The Examiner asserts that *Ludwig* discloses a "mark as corresponding to tag." (*Office Action*, p. 3). *Ludwig*, however, merely discloses that "business objects may receive XML messages in a predefined format and return XML response messages in a predefined format." (*Ludwig*, ¶ 0031). *Ludwig*'s "XML message[] in a predefined format" is not "a request configured in a first format at the server system,. . . includ[ing] **a tag that indicates a response format associated with the requesting entity,**" as recited in claim 1. (emphasis added). Because *Ludwig* does not disclose every element of claim 1, it cannot anticipate the claim, and Applicants request the reconsideration and withdrawal of the section 102(e) rejection of claim 1. Claims 16, 23, 28, 33, 34, 37, 38, 39, 49, 54, and 59, although different in scope from claim 1 and from each other, recite similar elements, and is therefore allowable for at least the same reasons. In addition, dependent claims 2-7, 9-15, 17-23, 24-27, 29-32, 35-36, 40-45, 47-48, 50-54, and 55-58

are allowable at least by reason of depending from one of allowable base claims 1, 16, 23, 28, 33, 34, 37, 38, 39, 49, 54, and 59.

Applicants respectfully traverse the rejection of claims 33-34, 37-39, 49, 54, and 59. As explained, the Examiner failed to address the particulars of claims 33-34, 37-39, 49, 54, and 59 in the Office Action. Accordingly, the Applicants are not in a position to address the rejection of those claims other than to assert that, like the foregoing response with regard to the rejection of claims 1-7, 9-45, and 47-59, claims 33-34, 37-39, 49, 54 and 57 are not anticipated by *Ludwig*.

As discussed above, claim 1 calls for a combination including the step of "receiving a request configured in a first format at the server system, wherein the request includes a tag that indicates a response format associated with the requesting entity." *Ludwig* fails to teach or suggest at least this element of claim 1. Instead, *Ludwig* merely teaches that "business objects may receive XML messages in a predefined format and return XML response messages in a predefined format." (*Ludwig*, ¶ 0031). *Virgin* fails to overcome *Ludwig*'s deficiencies.

As explained above, the Examiner failed to designate any particular part of *Ludwig* or *Virgin* in rejecting claims 33-34, 37-39, 49, 54, and 59 (*Office Action*, p. 5). As discussed above, *Ludwig* fails to teach or suggest at least a combination including the element of claim 1, discussed above. And *Virgin* merely teaches "a central invoicing system." (*Virgin*, Abstract). Accordingly, *Virgin* also fails to teach or suggest at least "receiving a request configured in a first format at the server system, wherein the request includes a tag that indicates a response format associated with the requesting entity," as recited in claim 1.

Ludwig and *Virgin*, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 1. For at least this reason, *Ludwig* and *Virgin* fail to support a *prima facie* case of obviousness of claim 1. Independent claims 33, 34, 37, 38, 39, 49, 54, and 59, although different in scope from claim 1 and from each other, recite similar elements, and are therefore allowable for at least the same reasons.

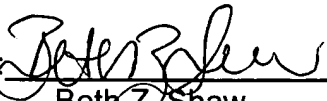
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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